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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,046	06/07/2002	Jocelle Thonnard	BM45414	6723
25308	7590	07/02/2004	EXAMINER	
DECHERT ATTN: ALLEN BLOOM, ESQ 4000 BELL ATLANTIC TOWER 1717 ARCH STREET PHILADELPHIA, PA 19103			BASKAR, PADMAVATHI	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/088,046

Applicant(s)

THONNARD, JOELLE

Examiner

Padmavathi v Baskar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 27-49 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**RESTRICTION**

1. Applicant's amendment filed on 3/14/02 has been entered.

**Status of claims**

2. Applicant requests (3/14/02) the office to cancel claims as filed in PCT.

Claims 1-26 have been canceled

New claims 27-49 have been entered. Please note Claim 38 depends on a canceled claim 21. Correction is required.

Claims 27-49 are pending in the application.

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 27,29, 32, 34, 35, 38 and 43-44 and 46 drawn to polypeptide and a method of inducing an immune response. (Further election of invention required, see Para # 4).

Group II, claims 28, 30, 31,33,36,37,39,40,41 and 42 drawn to DNA, vector and host cell. (Further election of invention required, see Para # 4).

Group III, claim 45 and 49 drawn to an antibody. (Further election of invention required, see Para # 4).

Group IV, claim 47 drawn to a method for diagnosing M.catarrhalis infection using peptide. (Further election of invention required, see Para # 4).

Group V, claim 47 drawn to a method for diagnosing M.catarrhalis infection using antibody. (Further election of invention required, see Para # 4).

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Group VI claim 48 drawn to a method for inducing immune response using polynucleotide. (Further election of invention required, see Para # 4).

Claim 47 recites multiple inventions that are drawn to a method of diagnosis using polypeptide and a method of diagnosis using antibody. Therefore, the examiner has included the claim 47 in two separate groups IV and V. Claim 47 will be examined to the extent it reads on the elected subject matter.

4. The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I is considered to be polypeptide, which is made up of amino acids.

The special technical feature of Group II is considered to be polynucleotide, which is made up of nucleic acid that shares no common structure, property and function with Group I, polypeptide as it contains amino acids.

The special technical feature of Group III is considered to be antibody that shares no common structure, property and function from Inventions I-II since it has an inherent affinity, avidity, and specificity that DNA or a simple protein is not capable of expressing and do not require each other for their practice.

Since the special technical feature of the Group I invention is not present in the Group II-III claims, and the special technical features of the Group II-III inventions are not present in the Group I claims, unity of invention is lacking.

The technical feature of linking Groups IV-VI is considered to be various methods utilizing reagents (i.e., products) that share no common structure, property and function. Therefore, the methods using such reagents are not so linked by the same or a

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corresponding special technical feature so as to form a single general inventive concept under Rule 13.1. Hence, unity is lacking among groups IV-VI.

Pursuant to 37 C.F.R. § 1.475 (d), the ISA/US considers that where multiple products, processes and methods are claimed, the main invention shall consist of the first invention of the category first mentioned in the claims and the first recited invention of each of the other categories related thereto. Accordingly the main invention (Group 1) comprises polypeptide, which is the first product and a first method of using polypeptide.

Further pursuant to 37 C.F.R. § 1.475 (d), the ISA/US considers that any feature which the subsequently recited products and methods share with the main invention does not constitute a special technical feature within the meaning of PCT Rule 13.2 and that each of such products and methods accordingly defines a separate invention. Therefore, the groups of inventions above do not constitute a special technical feature within the meaning of PCT Rule 13.2 and that each of such products and methods accordingly defines a separate invention.

Accordingly Groups I-VI are not so linked by the same or a corresponding special technical feature so as to form a single general inventive concept.

#### **DISTINCT INVENTIONS**

5. Inventions SEQ ID NO: 1 – 6 are not so linked as to under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The claimed peptide and polynucleotide share no common special technical feature because the polypeptide, SEQ.ID.NO: 2 or 4 or 6 and the nucleic acid sequence, SEQ.ID.NO: 1 or 3 or 5 have no common structure, function and property.

Thus, polypeptide as represented by SEQ.ID.NO: 2 or 4 or 6 and the polynucleotide as represented by SEQ.ID.NO: 1 or 3 or 5 are not linked by the same or a

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corresponding special technical feature so as to form a single general inventive concept. Therefore, where structural identity is required, such as for hybridization or expression of protein or binding of antibody, each sequence appears perform a different function in that peptides elicit an antibody response and nucleic acids encode peptides that specifically bind to an antibody. Thus they share no common structure and function so as to form a single general inventive concept under Rule 13.1. Hence, unity is lacking among SEQ.ID.NOS.

Applicant is required under Restriction is required under 35 U.S.C. 121 and 372 to elect a single disclosed SEQ.ID.NO from any group elected.

6. Applicant is required, in reply to this action, to elect a group and one sequence and identify the SEQ.ID.NO to which the claims shall be restricted. The reply must also identify the claims readable on the elected invention, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

7. Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform to the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The RightFax number for submission of before-final amendments is (703) 872-9306. The RightFax number for submission of after-final amendments is (703) 872-9307.

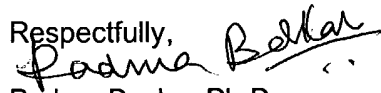
8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Padma Baskar Ph.D., whose telephone number is ((571) 272-0853. A message may be left on the Examiner's voice mail system. The Examiner

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can normally be reached on Monday to Friday from 6.30 a.m. to 4.00 p.m. except First Friday of each bi-week.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Respectfully,

  
Padma Baskar Ph.D.

7/1/04